REMARKS

Applicants respectfully request reconsideration and allowance of the application in view of the following remarks.

Request for Reconsideration of Final Office Action

Applicant requests reconsideration of the finality of the Office Action mailed January 19, 2006. Per MPEP 706.07(a), a final Action is proper on a second or subsequent action except when the examiner introduces a new ground of rejection that is not necessitated by applicant's amendment. The final Action mailed January 19, 2006 raises new grounds of rejection with respect to independent claims 41 and 46 that were not necessitated by amendment. To the contrary, the new grounds of rejection were necessitated by the insufficiency of the Windows 98 screen shots cited as reference in the previous Action mailed September 23, 2005.

Objections

The objection to canceled claim 43 was withdrawn.

Applicant requests clarification regarding the objection to claims 33, 39, 41 and 46. Contrary to the assertion in the Action, these claims were amended to obviate the objection. There appears to be no basis in the record for the objection to be maintained.

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Rejections Under 35 U.S.C. §112

Claims 31, 37, 41

Applicant traverses the rejection of claims 31, 37, and 41 Under 35 U.S.C. §112, first paragraph. The Action appears to assert that the language in the claims which recites *performing an action when an amount of available storage capacity on the storage device falls below a threshold* is not described in the specification. Applicant disagrees. Support for this subject matter may be found in the specification at least at page 5, lines 1-19, page 7, lines 25-30, page 13, lines 19-29, and page 19, line 23 – page 20, line 7, each of which describe *performing an action when an amount of available storage capacity on the storage device falls below a threshold.*

Claim 34

Claim 34 is canceled. Therefore, the rejection of claim 34 is moot.

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Rejections Under 35 U.S.C. §102

Claims 30, 31, 36 and 37

Claims 30, 31, 36 and 37 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,647,415 to Olarig, et al. (hereinafter, "the '415 patent"), or in the alternative as being obvious over the '415 patent. Applicant respectfully traverses these rejections.

Anticipation under 35 U.S.C. §102 requires that *each and every element* of the claim be set forth *in the manner recited in the claim* in a *single* prior art reference. (See, MPEP 2131). The '415 patent cannot anticipate (or render obvious) independent claims 30 and 36 because the '415 patent neither discloses (nor even suggests) limitations explicitly recited in independent claims 30 and 36. Claim 30 recites "sorting a plurality of data files on the storage device into one or more categories based on at least one characteristic of the data files" claim 36 recites "sort a plurality of data files on a storage device associated with the processor into one or more categories based on at least one characteristic of the data files."

The Action asserts that the '415 patent discloses these limitations, and now cites column 3, lines 6-11 to support the rejection. Applicant disagrees. The cited text reads as follows:

> FIG. 2 shows a flow chart of the transparent overflow storage process. Using any of various algorithms, each local workstation or PC periodically inspects the used capacity of its storage to determine whether some of the data stored on the PC needs to be moved to network storage (step 202).

Nothing in this text discloses (or even suggests) sorting a plurality of data files on the storage device into one or more categories based on at least one characteristic of the data files.

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Claim 30 further recites "reallocating a portion of the data in a category of data files when a storage capacity consumed by the category of data files exceeds a threshold" and claim 36 recites "reallocate a portion of the data in a category of data files when a storage capacity consumed by the category of data files exceeds a threshold." The Action asserts that the '415 patent discloses these limitations, and now cites Fig. 2, step 206 and column 3, lines 6-11 to support the rejection. Applicant disagrees. The cited text reads as follows:

> If a PC's storage space is nearing full capacity, the PC automatically determines which data has been least-recently used (step 204) and automatically moves such amount of data to the network server's storage so as to free up a previously determined percentage or magnitude of storage space on the PC, without notifying the user (step 206).
>
> Note that the amount of storage in use above the threshold for moving data (i.e., the minimum available storage) need not be the same as the amount of data moved. For example, a computer may be set to move data to network storage when there is less than 5% of storage free. When this threshold is reached, the machine will move enough data so as to free up 10% of storage.

Nothing in this text discloses (or even suggests) reallocating a portion of the data *in a category of data files* when a storage capacity consumed by the category of data files exceeds a threshold. This text appears to lack any reference whatsoever to applying thresholds to *categories* of data files. To the contrary, thresholds appear to be applied to entire disk drive capacities.

In sum, the '415 patent fails to disclose elements recited in independent claims 30 and 36. Hence the rejection of these claims under 35 U.S.C. §102(e) is improper and should be withdrawn.

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Dependent claims 31 and 37 depend from claims 30 and 36, respectively, and are allowable at least by virtue of this dependency.

Claims 41, 42 and 44-48

Claims 41, 42, and 44-48 were rejected under 35 U.S.C. §102(a) as anticipated by Jamsa 1001 Windows 98 Tips ("Jamsa"). Claims 46-48 are canceled herein. Thus the rejection of these claims is moot. Applicant traverses the rejection of claims 41, 42 and 44.

Anticipation under 35 U.S.C. §102 requires that *each and every element* of the claim be set forth *in the manner recited in the claim* in a *single* prior art reference. (See, MPEP 2131). Jamsa cannot anticipate independent claims 41 because Jamsa fails to disclose limitations explicitly recited in independent claims 41. Claim 41 recites a processor configured to "perform an action when an amount of available storage capacity on the storage device falls below a threshold." The Action asserts that Jamsa describes this limitation, and cites tip 133 in Jamsa. Applicant disagrees. Nothing in tip 33 discloses (or suggests) a processor configured to perform an action when an amount of available storage capacity on the storage device falls below a threshold, as recited in claim 41. Hence, Jamsa cannot anticipate claim 41.

Dependent claims 42 and 44 depend from claim 41, respectively, and are allowable at least by virtue of this dependency.

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Rejections Under 35 U.S.C. §103

Claims 31 and 36

Claims 30 and 36 were rejected in the alternative under 35 U.S.C. §103(a) as being obvious over the '415 patent. Applicant respectfully traverses these rejections.

To establish a *prima facie* case of obviousness the Action must establish that all limitations recited in the claim are disclosed or suggested by the cited reference. See, MPEP 2143.03. As noted above, the '415 patent fails to disclose, or even to suggest limitations recited in independent claims 30 and 36. Therefore, the Action fails to establish a *prima face* case of obviousness against claims 30 and 36.

Dependent claims 31 and 37 depend from claims 30 and 36, respectively, and are allowable at least by virtue of this dependency.

Claims 41, 42 and 44-48

Claims 41, 42, and 44-48 were rejected under 35 U.S.C. §103(a) as being obvious over the '415 patent, alone or in combination with Jamsa 1001 Windows 98 Tips ("Jamsa").

To establish a *prima facie* case of obviousness the Action must establish that all limitations recited in the claim are disclosed or suggested by the cited reference. See, MPEP 2143.03. As noted above, Jamsa fails to disclose, or even to suggest a processor configured to "perform an action when an amount of available storage capacity on the storage device falls below a threshold." Therefore, the Action fails to establish a *prima face* case of obviousness against claim 41.
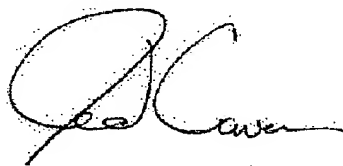
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Dependent claims 42 and 44-45 depend ultimately from claim 41 and

are allowable at least by virtue of the dependency.

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CONCLUSION

This application is in condition for allowance. Should any issue remain that prevents immediate issuance of the application, the Examiner is encouraged to contact the undersigned attorney to discuss the unresolved issue.

In the event the Examiner refuses to allow the case, Applicant requests entry of the claim amendments for purposes of appeal.

Respectfully Submitted,
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